

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Rejections under 35 USC § 103

- 1) The rejection of claims 1, 7, 13, 16 and 20 under 35 USC § 103(a) as being unpatentable over Takakado et al. in view of Ivner et al., is respectfully traversed.

In this rejection, it is acknowledged that Takakado et al. does not explicitly show that the inverter has a neutral output. To overcome this shortcoming, Ivner et al. is cited. Ivner et al. is held to disclose that “for the purpose of manufacturing a lower cost converter that part of the converter 8 has a neutral output” and Fig. 1 is advanced as showing this feature.

However, element(s) #2 are disclosed as being terminals which are intended to act as positive and negative output terminals. Further, Ivner et al. is completely silent as to the either of the terminals 22 being “neutral.” Indeed, column 4, lines 9 – 28 are such as to set forth:

A device for **converting current voltage between a first one-phase side 1, which is illustrated through two terminals 2, and a second three-phase side 3 is illustrated in FIG. 1. Such a device is suited for being a part of a power converter station for delivering electrical energy from a three-phase line to a single-phase railway supply line for electrically driver vehicles or conversely. The device has at the second side a transformer 4, with three primary windings 5, single for**

each phase, and three secondary windings 6 galvanically separated from each other. Thus, the transformer is arranged to transform the alternating voltage of one phase to an alternating voltage of another level through each couple of primary winding/secondary winding. In the case of a power converter station of the type mentioned, the voltage of the three-phase line is about 20 kV, and this is transformed to about 2,5 kV alternating voltage between the ends of the respective secondary winding, so that the components arranged in the converter modules described hereinafter will not be damaged. (Emphasis added)

An electronic search of Ivner et al. reveals a dearth of the term “neutral.” Indeed there appears to be nothing in this reference that would remotely induce any consideration by a hypothetical person of ordinary skill of transferring any teachings of Ivner et al. into the arrangement of Takakado et al.

It is respectfully submitted that the position that Ivner et al. discloses a neutral output is in error. Further, it is not seen that an alleged reduction in the cost of part of the converter would be sufficient motivation to induce consideration of a complete revision of the circuit arrangement disclosed in Takakado et al.

In order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be motivated to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required.

There are three possible sources for motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) This case law, however, establishes that, irrespective of the elements which are disclosed, without a motivation to combine, a rejection

attempting to establish a *prima facie* case of obvious must be held improper. Additionally, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In this instance, "cost" would, at the very best, merely be attributable to the level of skill in the art, and thus not be available as a suggestion to combine.

The rejections advanced in paragraphs #3-7, inasmuch as they are all founded on the basic combination of Takakado et al. and Inver et al., all suffer from the same tenability eliminating shortcomings and are summarily traversed on at least this basis.

Conclusion

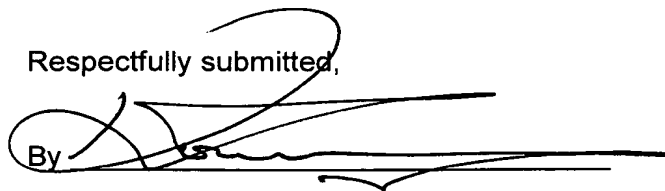
It is respectfully submitted that the unsupported assertion that Inver et al. discloses a neutral output along with the totally unsupported position that this feature alone has a direct effect on the cost savings which are advanced as being possible with the arrangement of Inver et al, is such as prevent a *prima facie* case of obviousness being established. Rational reason supported by the disclosure of the two basic references for the hypothetical person of ordinary skill to be motivated to consider a transfer of teachings from Inver et al. to Takakado et al., has not been established.

It is therefore respectfully submitted that the claims as they stand before the PTO are allowable over the art of record for at least the reasons advanced above. Favorable reconsideration and allowance of this application is courteously solicited.

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Respectfully submitted,

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